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UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

MEDIOSTREAM, INC.,

Case No.: 3:11-cv-2525 RS

Plaintiff,

V.

MICROSOFT CORPORATION, ET AL.,

Defendants.

**DEFENDANTS' MOTION FOR
LEAVE TO AMEND THEIR
INVALIDITY CONTENTIONS**

Date: August 24, 2012

Time: 9:30 a.m.

Judge: Hon. Joseph Spero

Location: Courtroom G, 15th Floor

UNREDACTED VERSION FILED UNDER SEAL

NOTICE OF MOTION AND MOTION

Please take notice that defendants Acer America Corp., Apple Inc., ASUS Computer International, Dell Inc., Gateway, Inc., Sonic Solutions LLC, Sony Electronics Inc., Sony Corporation, and Microsoft Corporation (collectively, "Defendants") submit this motion for leave to supplement and amend their invalidity contentions pursuant to P.R. 3-6(b). A hearing on this motion is set for August 24, 2012 before the Honorable Richard Spero, United States Magistrate Judge.

In this motion, Defendants ask the Court to grant them leave to supplement and amend their invalidity contentions pursuant to P.R. 3-6(b). In support of this motion, Defendants rely on the accompanying Memorandum and its exhibits, the Declaration of Christina Olson in support of the motion, and the exhibits accompanying the Declaration.

Respectfully submitted,

/s/ Scott Schrader

Scott Schrader

Counsel for Defendant Microsoft Corp.

TABLE OF CONTENTS

3	STATEMENT OF THE ISSUES TO BE DECIDED	1
4	STATEMENT OF UNDISPUTED MATERIAL FACTS	2
5	A. DirectX prior art reference.....	2
6	B. Citations to source code.....	2
7	C. Additional defenses	4
8	LEGAL STANDARD	5
9	ARGUMENT.....	6
10	I. This Court should permit Defendants to amend their invalidity contentions to identify DirectX 8.0 as prior art.....	6
11	II. This Court should permit Defendants to amend their invalidity contentions to provide new and corrected source code citations.....	7
12	III. This Court should permit Defendants to amend their invalidity contentions to assert defenses not based on prior art.....	10
13	CONCLUSION.....	12

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Golden Hour Data Sys., Inc. v. Health Servs. Integration, Inc.</i> , No. C06-7477, 2008 U.S. Dist. LEXIS 75495 (N.D. Cal. July 1, 2008).....	7, 9
<i>Halo Elecs., Inc. v. Bel Fuse Inc.</i> , No. C07-06222, 2010 U.S. Dist. LEXIS 97640 (N.D. Cal. Sept. 3, 2010)	5
<i>Streak Prods., Inc. v. Antec, Inc.</i> , No. C09-04255, 2010 U.S. Dist. LEXIS 97613 (N.D. Cal. Sept. 8, 2010)	5
STATUTES	
35 U.S.C. § 101.....	1, 4, 10, 11
35 U.S.C. § 102(b).....	7
35 U.S.C. § 102(f).....	4, 10, 11
35 U.S.C. § 112, ¶ 1.....	4, 10

1 Defendants Acer America Corp, Apple Inc., ASUS Computer International, Inc., Dell
 2 Inc., Gateway, Inc., Sonic Solutions LLC, Sony Electronics Inc., Sony Corporation, and
 3 Microsoft Corporation (collectively, "Defendants") respectfully request leave to supplement and
 4 amend their invalidity contentions pursuant to P.R. 3-6(b). Defendants' proposed amended
 5 invalidity contentions are attached to this Motion as Exhibits 1 to 6.

6 Defendants seek leave from the Court to modify their invalidity contentions in three
 7 respects. First, Defendants seek to supplement their anticipation and obviousness contentions
 8 with an additional piece of prior art. Second, Defendants wish to supplement their present
 9 contentions with respect to four prior art products by adding and correcting citations to the
 10 source code of those products. Third, Defendants seek to add additional invalidity defenses not
 11 based on prior art, including that Plaintiff failed to disclose the best mode for carrying out its
 12 invention, that the asserted patents are invalid for failure to name Ian Xie as an inventor, and
 13 that the patents fail to claim patentable subject matter pursuant to 35 U.S.C. § 101.

14 Defendants have diligently searched for prior art and have been careful to amend their
 15 invalidity contentions expeditiously once new information has come to light and as the case
 16 schedule and applicable rules have permitted. Plaintiff has known of these proposed
 17 amendments since late 2010, and would not be prejudiced by the granting of this motion. A
 18 denial of this motion, however, would prejudice Defendants, because each proposed amendment
 19 is material to the merits of this case. Good cause thus exists for granting Defendants leave to
 20 amend their invalidity contentions.

21 STATEMENT OF THE ISSUES TO BE DECIDED

22 Whether Defendants should be granted leave to supplement and amend their invalidity
 23 contentions to add an additional piece of prior art; supplement and correct source code citations
 24 in their current contentions; and add additional defenses based on Plaintiff's failure to disclose
 25 the best mode of the claimed invention, failure to name an inventor, and failure to claim
 26 patentable subject matter, where

27 (a) Defendants have been diligent in investigating the relevant prior art, source code,
 28 and facts underlying the additional defenses,

- (b) The proposed amendments are highly material to the merits of the case, and
- (c) Plaintiff has long known of these proposed amendments and would suffer no
harm if leave to amend and supplement were granted.

STATEMENT OF UNDISPUTED MATERIAL FACTS

Defendants seek leave to amend their invalidity contentions in three ways: to add the DirectX prior art reference; to add and correct source code citations for four other prior art references; and to add invalidity defenses not based on prior art. Defendants believe the facts below to be undisputed.

A. DirectX prior art reference

Defendants seek to add invalidity contentions related to the DirectX prior art reference, which are attached hereto as Exhibit 1, in response to Plaintiff's new infringement allegations against DirectX. DirectX is a feature of various Microsoft accused products, including the Windows XP, Windows Vista, and Windows 7 operating systems. DirectX was first accused in amended infringement contentions that Plaintiff provided, in draft form, to Microsoft on May 7, 2010. Olson Decl. Ex. A.

In the amended contentions submitted with its motion, Plaintiff contends that DirectX satisfies elements of the asserted claims. Dkt. No. 310. Microsoft denies that DirectX infringes. Defendants contend that prior versions of DirectX, including versions that predate the asserted patents, include the same or similar features to those that Plaintiff now accuses of infringement. Therefore, in order to properly refute Plaintiff's amended infringement contentions, Defendants seek leave to supplement their invalidity contentions with a claim chart for Microsoft DirectX 8.0, which predates the asserted patents.

B. Citations to source code

Defendants seek to supplement their invalidity claim charts with citations to the source code for four prior art products previously disclosed. First, Defendants seek to add citations to the source code in the claim charts for Ulead VideoStudio 5.0 DVD Edition (“VideoStudio”), which are attached hereto as Exhibit 2. In contentions served in March 2010, Defendants asserted that VideoStudio invalidates the asserted patents, providing a claim chart for the

1 reference. Olson Decl. Ex. B. Defendants did not then have access to VideoStudio's source
 2 code. Olson Decl. ¶ 5. Defendants stated that they were actively working to acquire the source
 3 code for VideoStudio and that they intended to amend their invalidity contentions as soon as
 4 they had received and reviewed the source code. Dkt. No. 210 at 11. Despite Defendants'
 5 diligent efforts, it took some time to receive that source code. Defendants served a subpoena
 6 seeking the VideoStudio source code on November 5, 2009, Olson Decl. Ex. C, but did not
 7 receive any code until July 1, 2010. Olson Decl. ¶ 5. Defendants received additional source
 8 code on August 23 and August 27. Olson Decl. ¶ 6. Defendants' expert Jeffrey Rowe
 9 completed his review of the VideoStudio source code on October 7, 2010. Olson Decl. ¶ 7. On
 10 November 9, 2010, the Court of Appeals for the Federal Circuit stayed this litigation pending
 11 disposition of Defendants' mandamus petition seeking transfer of venue. Per Curium Order, *In*
 12 *re Acer*, Misc. Dkt. No. 942 (Fed. Cir. Nov. 9, 2010)

13 Second, Defendants seek to add citations to the source code for MedioStream's prior art
 14 neoDVD product, as reflected in Exhibit 3 hereto. Defendants served supplemental invalidity
 15 contentions containing source code citations for neoDVD on July 8, 2010. Olson Decl. Ex. D.
 16 On July 28, 2010, MedioStream produced additional source code. Olson Decl. ¶ 9 and Ex. E.
 17 Defendants' expert reviewed this source code between July 28 and October 14, 2010. Olson
 18 Decl. ¶ 10. Defendants seek to add source code citations as a result of this additional expert
 19 review.

20 Third, Defendants seek to correct and add a few source code citations in their invalidity
 21 claim chart for the prior art product Windows Movie Maker 1.1 ("Movie Maker"), as reflected
 22 in Exhibit 4 hereto. These source code citations have been added for the sake of completeness;
 23 for the most part, this modification involves repeating citations that already exist in the version
 24 of this chart already before the court, but for additional claims. See Olson Decl. Ex. F (blackline
 25 of changes between operative and proposed Movie Maker claim charts).

26 Fourth, Defendants likewise seek to make minor additions to the claim chart for the
 27 prior art VideoFactory 2.0 ("VideoFactory") product, to correct certain clerical errors and to
 28

1 clarify their invalidity theory, as reflected in Exhibit 5. *See* Olson Decl. Ex. G (blackline of
 2 changes between operative and proposed VideoFactory claims charts).

3 **C. Additional defenses**

4 Defendants seek to supplement their invalidity contentions by disclosing three additional
 5 defenses, as reflected in Defendants' amended invalidity contentions attached hereto as Exhibit
 6. First, Defendants seek to assert a best-mode defense pursuant to 35 U.S.C. § 112, ¶ 1. The
 7 best-mode defense is based on the depositions of the named inventor, Qiang Huang, who
 8 testified that [REDACTED] Olson

9 Decl. Ex.H at 43:19-44:1. MedioStream nonetheless did not disclose [REDACTED]

10 [REDACTED] to the Patent and Trademark Office when it filed the applications that issued as the
 11 asserted patents. Olson Decl. Ex. I. Since Mr. Huang's deposition, Defendants have diligently
 12 pursued discovery for the best-mode defense, including the deposition of Plaintiff's president,
 13 Cheng Kao, on September 22, 2010. At that deposition, Dr. Kao testified that [REDACTED]

14 [REDACTED]
 15 [REDACTED]
 16 Olson Decl. Ex. J at 162:16-19; 161:13-17; 172:8-173:2.

17 Second, Defendants seek to assert a defense that the asserted patents are invalid under
 18 35 U.S.C. § 102(f) for failure to name Ian Xie as an inventor. Mr. Xie testified at his deposition
 19 that [REDACTED]

20 Olson Decl. Ex. K at 98:11-20.
 21 [REDACTED]
 22 Olson Decl. Ex. K at 98:11-20. [REDACTED]

23 Olson Decl. Ex. K at 92:12-93:3. These facts, which form the basis for Defendants'
 24 inventorship defense, were not available to Defendants until Mr. Xie's deposition on May 7,
 25 2010, after the deadline for serving invalidity contentions. Olson Decl. ¶20.

26 Third, Defendants seek to add two sentences to their invalidity contentions asserting that
 27 the asserted patents are invalid under 35 U.S.C. § 101 because the claims are directed to non-
 28 statutory subject matter. This defense is based on the PTO's Final Rejection on September 28,

2010, of several proposed claims in a continuation proceeding descending from one of the asserted patents. Olson Decl. Ex. L.

While this case was still pending before the Eastern District of Texas, defendants provided these proposed amended contentions to Plaintiff. Olson Decl. ¶ 20 and Ex. M.¹ The substance of the best-mode and inventorship contentions was also disclosed in Dr. Bovik's expert report, served on October 22, 2010. Olson Decl. ¶ 19. At the time that the Federal Circuit ordered this case temporarily stayed, the parties were still in the process of meeting and conferring over these proposed amendments. Olson Decl. Ex. M. As a result, no formal motion on these contentions was previously filed.

LEGAL STANDARD

Under Federal Rule of Civil Procedure 16(b), a party seeking to modify a court’s docket control order must show “good cause.” Fed. R. Civ. P. 16(b). Likewise, Patent Local Rule 3-6 allows parties to supplement their invalidity contentions “by order of the Court upon a timely showing of good cause.” Absent “undue prejudice to the non-moving party,” the “recent discovery of material, prior art despite earlier diligent search” supports such good cause. Patent L.R. 3-6; *see also Streak Prods., Inc. v. Antec, Inc.*, No. C09-04255, 2010 U.S. Dist. LEXIS 97613, at *5 (N.D. Cal. Sept. 8, 2010). “In determining whether there is good cause, ‘the critical issue is whether or not [the moving party] exercised diligence in discovering the prior art.’” *Streak Prods.*, 2010 U.S. LEXIS 97613, at *5-*6 (quoting *Sunpower Corp. Sys. v. Sunlink Corp.*, No. C08-02807, 2009 U.S. Dist. LEXIS 85425, at *4 (N.D. Cal. June 12, 2009)).

“Nevertheless, judges in this district have recognized that the Patent Local Rules are ‘not a straitjacket into which litigants are locked from the moment their contentions are served. There is a modest degree of flexibility, at least near the outset.’” *Halo Elecs., Inc. v. Bel Fuse Inc.*, No. C07-06222, 2010 U.S. Dist. LEXIS 97640, at *8 (N.D. Cal. Sept. 3, 2010) (quoting

¹ Defendants' VideoFactory 2.0 invalidity claims charts were inadvertently emailed to plaintiff without the appropriate confidentiality designation. The proposed amended VideoFactory 2.0 invalidity claims charts, attached as Exhibit 5 to this Motion, are identical to the version sent to plaintiff by defendants on October 21, 2010, except that it is now correctly designated as "CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE."

Comcast Cable Commc’ns Corp., LLC v. Finisar Corp., No. C06-04206, 2007 U.S. Dist. LEXIS 98476, at *5 (N.D. Cal. Mar. 2, 2007)). Courts in this district have also considered factors such as “whether the moving party was diligent in amending its contentions, the relevance of and difficulty in locating the newly-discovered prior art, whether the request to amend is motivated by gamesmanship, and prejudice to the non-moving party should the motion amend be granted.” *Streak Prods.*, 2010 U.S. LEXIS 97613, at *6.

ARGUMENT

I. The Court should permit Defendants to amend their invalidity contentions to identify DirectX 8.0 as prior art.

Good cause exists for Defendants to amend their invalidity contentions and identify DirectX 8.0 as prior art. Defendants seek to add DirectX 8.0 as an invalidating reference in direct response to Plaintiff's motion for leave to amend its infringement contentions against Microsoft. Plaintiff has asserted that the current version of DirectX satisfies many of the limitations of the asserted patents — an assertion that Plaintiff first made in draft amended infringement contentions sent to Microsoft on May 7th, 2010. Olson Decl. ¶ 2. Microsoft denies that DirectX infringes.

Defendants seek to assert DirectX 8.0 as a prior art reference to demonstrate that the asserted patents are invalid even under Plaintiff’s view of those patents. Defendants did not receive Plaintiff’s new contentions until after the deadline for Defendants to serve their invalidity contentions pursuant to Texas Local Patent Rule 3-3, and so could not have anticipated Plaintiff’s argument. *See* Olson Decl. ¶ 20. MedioStream’s motion for leave to amend its contentions to add DirectX was granted on October 18, 2010, just prior to the case being stayed. Dkt. No. 468.

DirectX 8.0 is important to Defendants' invalidity defense. MedioStream has asserted that the Microsoft Windows XP, Windows Vista, and Windows 7 operating systems infringe the asserted patents, relying, in part, on functionality provided by DirectX.² Microsoft denies that

² MedioStream also cites DirectShow and DirectShow Editing Services in their amended infringement contentions, but DirectShow and DirectShow Editing Services are part of DirectX.

any of its products infringe the asserted patents. However, given MedioStream's claim that the accused Microsoft operating systems somehow practice the asserted claims, DirectX 8.0 would be strong evidence that those claims were either anticipated or obvious under Plaintiff's contentions. DirectX 8.0 is an earlier version of the DirectX package that MedioStream cites in its infringement contentions. It contains many of the same or similar functions as the current version of DirectX, but was released to the public on November 9, 2000, Olson Decl. Ex. N, and is, therefore, prior art under 35 U.S.C. § 102(b). Thus, DirectX 8.0 is an important prior art reference to show that the asserted claims are invalid under MedioStream's view of the asserted patents. As DirectX 8.0 is "relevant to the merits of the case, it would be unjust for such information 'to be avoided on the basis of . . . mere technicalities.'" *Golden Hour Data Sys., Inc. v. Health Servs. Integration, Inc.*, No. C06-7477, 2008 U.S. Dist. LEXIS 75495, at *12 (N.D. Cal. July 1, 2008) (citation omitted) (granting motion to amend invalidity contentions).

Moreover, Plaintiff would not be prejudiced by Defendants' amendment to include DirectX 8.0 as an invalidating prior art reference. Plaintiff was the first to assert that DirectX provides functionality claimed in the asserted patents. Defendants seek only to be permitted to show that the same or similar functionality was provided by an earlier version of DirectX. Moreover, Plaintiff has known of this proposed contentions since late 2010. Olson Decl. Ex. M. Considering that Plaintiff has already had ample opportunity to investigate the operation of DirectX, there is more than enough time for Plaintiff to respond to Defendants' amended contentions. Indeed, denying the motion would prejudice *Defendants*, since it would put them in the position of being unable to fully respond to Plaintiff's latest infringement allegations.

II. The Court should permit Defendants to amend their invalidity contentions to provide new and corrected source code citations.

Good cause also exists for Defendants to amend their invalidity contentions to provide additional source code citations for the VideoStudio, Movie Maker, neoDVD, and VideoFactory prior art references.

First, Defendants seek to add citations to VideoStudio source code that was not available when Defendants provided their original VideoStudio claim chart in March 2010 and that

1 Defendants have diligently sought to procure. Although Defendants served Corel Inc. with a
 2 subpoena requesting VideoStudio source code in November 2009, Defendants did not receive
 3 any source code for VideoStudio until July 2010, and even then, the source code that they
 4 received was incomplete. Olson Decl. ¶¶ 4-6. Defendants continued to receive additional
 5 source code from Corel through August 27, 2010. Olson Decl. ¶ 6. Defendants diligently
 6 reviewed all of the source code that had been produced, completing their review on October 7,
 7 2010. Olson Decl. ¶ 7. This case was subsequently stayed on November 9, 2010 pending
 8 disposition of Defendants' mandamus petition seeking transfer of venue.

9 Second, Defendants seek to add source code citations for neoDVD, MedioStream's prior
 10 art product. Defendants provided MedioStream with a supplemental invalidity claim chart on
 11 July 8, 2010. Olson Decl. Ex. D. A few weeks later, on July 28, 2010, MedioStream produced
 12 a significant volume of neoDVD source code. Olson Decl. ¶ 9. Defendants' expert, Jeffrey
 13 Rowe, reviewed the neoDVD source code but was unable to complete his review until October
 14 2010. Olson Decl. ¶ 10. Defendants have been diligent in their efforts to acquire the source
 15 code and have provided the amended claim chart as quickly as possible after completing their
 16 review. Mr. Rowe also provided an expert invalidity report, in October 2010, that detailed these
 17 source code level contentions. Olson Decl. ¶ 22.

18 Third, Defendants seek to add a few source code citations to their Movie Maker claim
 19 chart, which already includes numerous source code citations. Defendants simply seek to
 20 correct some citations and clarify that some citations are relevant to multiple claim limitations.
 21 Plaintiff has been aware that Defendants contend that Movie Maker invalidates the asserted
 22 patents under Plaintiff's contentions since at least April 3, 2009, Olson Decl. Ex. O, and it has
 23 already examined the product's source code, so these additional source code citations will
 24 require little in the way of additional effort by Plaintiff or its experts.

25 Fourth, and likewise, Defendants seek to correct and supplement their VideoFactory
 26 claim chart. The edits to that claim chart fix clerical errors and clarify the Defendants'
 27 invalidity theories. They also add some screen shots to show additional ways that certain steps
 28

1 can be performed by the prior art product. *See* Olson Decl. Ex. G (blackline of changes between
 2 operative and proposed VideoFactory claims charts).

3 These amendments are material to the merits of the case because the asserted claims of
 4 the '655 patent recite a system with "code directed to" various functions. Likewise, some
 5 asserted claims recite process steps that are not always easily confirmed from external
 6 observation, but that can be more readily determined by careful examination of the source code.
 7 For example, the Court's claim construction requires "resizing of the video before changing its
 8 frame rate." Since the user of a software program may not be able to see the order in which
 9 those steps occur, source code citations can often be important in determining the order of the
 10 steps in the prior art.

11 Moreover, Plaintiff would face no prejudice from the source code citations Defendants
 12 seek to add to their invalidity contentions. Defendants' amendments "do not raise new issues
 13 but instead merely supplement [their] initial contentions," and Plaintiff "was already on notice
 14 regarding the substance of [the] proposed amendments." *Golden Hour Data Sys.*, 2008 U.S.
 15 Dist. LEXIS 75495, at *13 (granting motion to amend invalidity contentions). Plaintiff has been
 16 aware of VideoStudio since at least March 5, 2010, when Defendants filed their unopposed
 17 motion to add the VideoStudio claim chart to their invalidity contentions. Dkt. No. 210 at 11.
 18 Plaintiff was aware that Defendants were working to acquire the VideoStudio source code and
 19 that Defendants intended to supplement their contentions with source code citations. *Id.*
 20 Moreover, the source code citations do not substantively change Defendants' contentions, but
 21 instead serve only to clarify and explain the factual basis for Defendants' existing contentions.

22 With respect to neoDVD, Plaintiff has been aware of this prior art product far longer
 23 than Defendants, as it is its own product. Accordingly, it is familiar with the product's source
 24 code and features, and there would be no prejudice in allowing the amendment.

25 With respect to Movie Maker, Plaintiff has been aware of this prior art product since at
 26 least April 3, 2009, when several defendants served invalidity contentions citing the product,
 27 and is well acquainted with the product's source code. Olson Decl. Ex. Q. The new citations do
 28 not expand Defendants' invalidity contentions, but merely provide additional detail supporting

1 those contentions. *See* Olson Decl. Ex. F (blackline of changes between operative and proposed
 2 Movie Maker claim charts). Moreover, the new citations are minor: they reference only six
 3 computer files, nearly all of which are cited elsewhere in the contentions. Olson Decl. Ex. F.
 4 Since Plaintiff has already examined nearly all the code in the new citations, and would not need
 5 to re-review that code, there would be no prejudice in allowing the amendment.

6 Finally, with respect to VideoFactory, plaintiff has been aware of this prior art reference
 7 since June 23, 2009, Olson Decl. Ex. P, and the changes in the amended contentions are not
 8 significant. Instead, they correct clerical errors; clarify the bases for Defendants' contentions;
 9 and provide additional screen shots showing that elements of the claimed invention were present
 10 in the reference. *See* Olson Decl. Ex. G (blackline of changes between operative and proposed
 11 VideoFactory claims charts).

12 **III. This Court should permit Defendants to amend their invalidity contentions to assert
 13 defenses not based on prior art.**

14 Good cause also exists for Defendants to amend their invalidity contentions to disclose
 15 additional defenses not based on prior art, including a best-mode defense under 35 U.S.C. § 112,
 16 ¶ 1, an inventorship defense under 35 U.S.C. § 102(f), and a patentable-subject-matter defense
 17 under 35 U.S.C. § 101. While the Patent Local Rules do not require disclosure of best-mode
 18 and patentable-subject-matter defenses in defendants' invalidity contentions, *see* Patent L. R.
 19 3-3, the convenience of the tribunal is best served by consolidating invalidity defenses in a
 20 single pleading. Moreover, good cause to amend exists, as Defendants have been diligent in
 21 investigating the facts supporting these non-prior art defenses.

22 Defendants seek to disclose three additional invalidity defenses. First, Defendants allege
 23 that Plaintiff failed to disclose the best mode of carrying out its invention. As the best-mode
 24 defense is based on Plaintiff's nondisclosure, Defendants were not in a position to provide
 25 detailed contentions relating to the defense until they obtained relevant discovery. For example,
 26 Mr. Huang, the named inventor, revealed what he considered the best mode of carrying out his
 27 invention when he testified that [REDACTED]
 28 [REDACTED] Olson Decl. Ex. H at 43:19-44:1. [REDACTED]

1 [REDACTED]
 2 [REDACTED] Olson Decl. Ex. H at 43:19-44:1. Yet the
 3 details of this best mode of operation are not identified in the specification and were not
 4 disclosed to the Patent and Trademark Office. Olson Decl. ¶ 25.

5 Following Mr. Huang's deposition, Defendants diligently investigated the facts
 6 surrounding the failure to disclose the best mode, despite obstacles erected by Plaintiff. For
 7 example, Plaintiff only recently produced internal documents describing [REDACTED]

8 [REDACTED]
 9 [REDACTED] Olson Decl. ¶ 26 and Ex. Q. Dr. Cheng Kao, MedioStream's
 10 president, reiterated [REDACTED] Olson

11 Decl. Ex. J, yet Plaintiff did not offer him for deposition until September 22, 2010.

12 Second, Defendants seek to disclose an inventorship defense under 35 U.S.C. § 102(f).
 13 Like the best-mode defense, this defense stems from evidence uncovered during depositions and
 14 subsequent document productions by Plaintiff. Olson Decl. Ex. K at 98:11-20. Accordingly,
 15 Defendants were not in a position to assert the defense until after the deadline for serving
 16 invalidity contentions and shortly before the case was stayed by the Federal Circuit.

17 Third, Defendants seek to disclose a patentable-subject-matter defense under 35 U.S.C.
 18 § 101. The basis for this defense is the PTO's rejection of claims for which MedioStream
 19 sought to obtain patent protection in a continuation application. That rejection was not entered
 20 until September 28, 2010. Olson Decl. Ex. L. Defendants were not in a position to assert the
 21 defense until after the PTO's rejection.

22 Each of these defenses provides a separate and independent ground of invalidity quite
 23 apart from the prior art that renders the asserted claims anticipated or obvious. As wholly
 24 distinct grounds for invalidity, the best mode, inventorship, and patentable subject matter
 25 defenses are not cumulative of any invalidity contentions already disclosed. Moreover, because
 26 each defense provides a separate and independent ground of invalidating the asserted patents,
 27 these defenses are highly material to the merits of the case.

As noted above, the facts supporting Defendants' best mode and inventorship defenses were known to Plaintiff, and not Defendants, even before Plaintiff brought this lawsuit. As such, Plaintiff would not be prejudiced by those amendments as it has had in its possession all facts relevant to the defenses. Additionally, Plaintiff has been aware of Defendants' inventorship defense since at least June 9, 2010, when Sony disclosed the defense to MedioStream. Olson Decl. Ex. R. Moreover, the patentable subject matter defense is a pure question of law requiring no discovery; accordingly, Plaintiff will not be prejudiced by that addition. Finally, Plaintiff could not possibly be prejudiced by the best mode and patentable subject matter defenses because the Patent Local Rules do not even require Defendants to include those defenses in their invalidity contentions. This factor therefore also weighs in Defendants' favor.

CONCLUSION

13 For the foregoing reasons, Defendants have shown good cause for amending their
14 invalidity contentions under Patent Local Rule 3-6. Defendants respectfully request that this
15 Court grant Defendants' Motion for Leave to Supplement and Amend Invalidity Contentions.

Dated: July 18, 2012

Respectfully submitted,

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SIGNATURE ATTESTATION

Pursuant to General Order 45, section X.B., I attest that I have obtained consent to file for all signatures indicated by the mark “/s/” within this electronically filed document.

/s/ Scott Schrader

Scott Schrader

Counsel for Defendant Microsoft Corporation